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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,264	12/03/2003	Tomohisa Sakurai	P/16-343 DIV	7089
2352 7590 03/25/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
ROY, BAISAKHI				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
03/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/728,264

Applicant(s)

SAKURAI ET AL.

Examiner

BAISAKHI ROY

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection with respect to the various embodiments in Ishikawa to address the newly added subject matter.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. Ishikawa et al. disclose an ultrasonic treatment instrument comprising an ultrasound transducer, which generates ultrasonic waves (9), a battery to supply energy to a drive circuit (254, col. 18 lines 41-47), a housing incorporating the ultrasonic transducer, the battery and the drive circuit (304), a probe having a distal end protruding from the housing and a part that is coupled with the ultrasonic transducer so that the ultrasonic waves are propagated by the probe outside the housing (309, fig. 19 lines 54-67), a movable member operable by direct manipulation by a hand of an operator (302), where the handpiece has a therapeutic part and an operating part and is manipulated by the operator's hand with the handle (col. 19 lines 45-53, col. 21 lines 42-51). The drive circuit is structured to drive the transducer responsive to the detection of movement of the movable member (334, col. 21 lines 18-40). The sensor circuit

includes a switch for movement of the movable member and supplying energy from the battery to the drive circuit (303, col. 21 lines 18-55). The instrument further includes switch for supplying energy to the drive circuit (313 col. 21 lines 56-66). The therapeutic part is located at the distal end of the probe to perform treatment with the ultrasonic waves and a movable treatment section provided at the distal end and movable interlockingly with an operation of the movable member (col. 19 lines 48-67). Ishikawa et al. teach that the variation in the amplitude of vibrations made by the distal part of the trocar assembly is dependent on the magnitude of pressure applied to the distal part (col. 17 lines 10-23). The amount of ultrasonic energy applied is changed according to the magnitude of movement of applied pressure which is judged by the processor unit. Therefore the ultrasonic transducer provides an amount of ultrasonic energy depending on the magnitude of movement of the moveable member.

4. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. in view of Salcudean et al. (6425865). Ishikawa et al. teach the use of a certain force to drive into the body cavity but do not explicitly teach detecting the magnitude of a torque developed by the movable member. In the same field of endeavor Salcudean et al. disclose an ultrasonic treatment instrument with a force-torque sensor embedded within an axis of rotation associated with the movable member measuring the forces and torques that are applied on the ultrasound probe (col. 7 lines 18-33, col. 8 lines 3-14). It would have therefore been obvious to one of ordinary skill in the art to use the teaching by Salcudean et al. to modify the teaching by Ishikawa et al. for the purpose of effectively coordinating the motion and forces of the probe (abstract).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BAISAKHI ROY whose telephone number is (571)272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian L Casler/
Supervisory Patent Examiner, Art
Unit 3737

BR
/B. R./
Examiner, Art Unit 3737